

REMARKS

Claim 6 has been canceled and claims 11 – 27 have been withdrawn. The remaining claims are presented without amendment.

In addition, it is noted that the Office Action fails to present any specific grounds of rejection respecting claims 31, 33 and 40. As a result, the Applicant was effectively denied the opportunity to address the rejection of these claims. Accordingly, it is believed that the finality of the Office Action should be withdrawn.

- A. Claims 1, 2, 28, 37, 29, 38, 32, 41, 42, 34, 43, 35, 44, 36, 45, 4, 5 and 7 – 10 very clearly patentably distinguish over U.S. Patent 4,923,547 to Yamaji et al.

The standard for lack of novelty or “anticipation” is one of strict identity. As stated by the Court of Appeals for the Federal Circuit in *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 USPQ 81, 90 (Fed. Cir. 1986), “it is axiomatic that for prior art to anticipate under § 102 it has to meet every element of the claimed invention” In *In re Donohue*, 766 F.2d 531, 534, 226 USPQ 619, 621 (Fed. Cir. 1985), it was stated that “an anticipation rejection requires a showing that each limitation of the claim must be found in a single reference, practice or device.”

The Yamaji et al. reference relates to a composite molded article made from a nonwoven fibrous mat. The Yamaji et al. reference explicitly teaches the use of monofilament fibers having a length of between 10 to 200 mm, or a

maximum of 0.2 meters. In contrast, the present invention reads on a conformable veil comprising "a plurality of fibers having an average length of between approximately 0.5 and 2 meters". Clearly the explicit fiber length range taught in Yamaji et al. differs and does not overlap with the average length range set forth in claim 1. Thus, it is clear that the Yamaji et al. reference fails to teach all the claim elements and does not establish a proper basis for rejection under 35 U.S.C. 102.

In fact, the Yamaji et al. reference fails to provide a proper basis for the rejection of claim 1 under any basis. More specifically, it is a specific objective of the Yamaji et al. reference to provide a lightweight composite molded article with excellent "moldability" (see col. 2 lines 36—40). In order to achieve this objective, the Yamaji et al. reference explicitly teaches that the fibers must have a length between 10 to 200 mm (see col. 2 lines 57—59, col. 3 line 65 to col. 4 line 2 and all the independent claims 1, 15, 22 and 27 of the Yamaji et al. reference).

The claimed fiber length of 0.5 to 2.0 meters set forth in present claim 1 clearly falls well outside the range of 10 to 200 mm explicitly taught in Yamaji et al. Since Yamaji et al. explicitly teaches that a maximum fiber length of 200 mm is critical in order to achieve the desired "moldability" objective, it should be appreciated that the Yamaji et al. reference actually teaches away from the presently claimed invention. It is well established that it is error to find obviousness where the prior art relied upon diverges from and teaches away from the invention at hand. See *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 220

USPQ 303, 311 (Fed. Cir. 1983) and *In re Fine*, 5 USPQ2d 1596, 1599 (Fed. Cir. 1988).

In point of fact, the modification proposed by the Examiner is contrary to the explicit teachings of Yamaji et al. which explicitly set a maximum fiber length of 200 mm. By suggesting a modification requiring the use of fibers that are longer than the maximum length taught in Yamaji et al., the Examiner's proposed modification essentially renders the Yamaji et al. reference unsatisfactory for its intended objective and purpose: that is, to provide an article with excellent "moldability". Where a proposed modification renders the prior art invention being modified unsatisfactory for its intended purpose, it is well established there is no suggestion or motivation to make the proposed modification. See MPEP § 2143.01 citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Thus, it is clear that the Yamaji et al. reference fails to provide any basis whatsoever for the rejection of independent claim 1 and claim 1 should be allowed.

Claims 2, 4, 5 and 7–10 which depend from claim 1 and are rejected on the same grounds are equally allowable for the same reasons.

Similarly, independent claim 28 also patentably distinguishes over this art and should be allowed. Claim 28 reads upon a conformable veil wherein the fibers have an average length of between approximately 0.5 and 3 meters. Again, the claimed length is well above the maximum length explicitly taught by Yamaji et al. in order to provide the desired "moldability" for the fibers. Thus, claim 28

is patentable over the Yamaji et al. reference for the same reasons discussed above with respect to claim 1. Claims 29, 32, 34 and 36 which depend from claim 28 and are rejected on the same grounds are equally allowable for the same reasons.

Independent claim 37 reads on a conformable veil comprising a plurality of fibers having an average length of between approximately 1 and 3 meters. Again, the length of the fibers is well above the maximum that is explicitly taught as required to meet the desired objective and purpose of "moldability" in the Yamaji et al. reference. Accordingly, Yamaji et al. teaches away from the present invention and there is no suggestion or motivation to lead one skilled in the art to make the modification proposed by the Examiner. Thus, claim 37 patentably distinguishes over the art and should be allowed. The same is true with respect to dependent claims 38 and 41–45 which are rejected on the same grounds and, therefore, are equally allowable for the same reasons.

B. Claims 3, 30 and 39 clearly patentably distinguish over the Yamaji et al. patent when considered in combination with U.S. Patent 4,579,774 to Kuwazuru et al.

As noted above, the primary reference to Yamaji et al. explicitly teaches that the fibers are limited to a maximum length of 200 mm in order to meet the objective and purpose of Yamaji et al. to provide the desired "moldability". The Kuwazuru et al. reference explicitly teaches the use of fibers having a length of

0.01 to 30 mm (see col. 3 lines 28-31). Thus, both the primary reference to Yamaji et al. and the secondary reference to Kuwazuru et al. explicitly teach or suggest the use of fibers that are much shorter than those explicitly set forth in independent claims 1, 28 and 37 from which claims 3, 30 and 39, respectively, depend. Clearly both the primary and secondary references teach away from the present invention. Further, the proposed modification of the Examiner is absolutely contrary to the explicit teachings of Yamaji et al. relating to the maximum usable length of fibers in order to meet the explicit "moldability" objective of the Yamaji et al. patent. Thus, it is clear that claims 3, 30 and 39 patentably distinguish over this art and should be allowed.

C. Conclusion

In summary, all the pending claims patentably distinguish over the prior art and should be formally allowed. Upon careful review and consideration it is believed the Examiner will agree with this proposition. Accordingly, the early issuance of a formal Notice of Allowance is earnestly solicited.

If any fees are required in respect to this amendment, please debit them
from Deposit Account 50-0568.

Respectfully submitted,

By: Margaret S. Millikin
Margaret S. Millikin
Reg. No. 38,969

Owens Corning
Patent Dept. Bldg. 11
2790 Columbus Road
Granville, Ohio 43023
(740) 321-7167

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